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SEP 18 2008

Docket No.: 041-2057C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:
Ryota TSUKIDATE	:Confirmation No. 3199
	:
Serial No. 10/684,643	:Group Art Unit: 2615
	:
Filed: October 15, 2003	:Examiner: ONUAKU, Christopher
For: MULTIMEDIA RECORDER WITH ENHANCED EPG-RELATED FUNCTIONS	

Honorable Commissioner of Patents
PO BOX 1450
Alexandria, VA 22313-1450

**PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT
UNDER 37 CFR 711.03(c)(1)(A) and 37 CFR 1.181(a)**

**FILED BY FACSIMILE 1 571 273 8300
on September 18, 2008**

Sir,

FACTS

1. An Office Action was issued by Examiner Onuaku on November 1, 2007. This action set forth a response period of three (3) that would have expired on February 1, 2008 absent the filing of one or more Petitions to extend this response date. If all extensions of time permitted in this matter were petitioned for and granted, the response period would have been the statutory response period of six (6) months that would have expired on May 1, 2008.

2. The referenced action was addressed to the undersigned attorney at his former address of 5522 Riva Ridge Drive, Wesley Chapel, Florida 33544. This attorney's address had previously been communicated to the Patent Office in a paper filed January 26, 2005. The Patent Office record, as set forth in Public PAIR, acknowledges receipt of this Change of Address form on January 26, 2005.

3. A second Change of Address form was filed in the Patent Office by the undersigned attorney on November 13, 2005. This second Change of Address form communicated the undersigned attorney's new address to be 424 Lantana Park, Lexington, Kentucky 40515. This second Change of Address form is acknowledged to have been received by the Patent Office on November 13, 2005 as set forth in Public PAIR. Therefore, as of November 13, 2005, the undersigned attorney's address for all matters pertaining to this application and the United States Patent Office is and was 424 Lantana Park, Lexington, Kentucky 40515.

4. The referenced action, not having been sent to this Kentucky address, but rather having been sent to the above referenced Florida address was not received by the undersigned attorney prior to July 24, 2008. The first notice that an Office Action had been issued in the above referenced application was received by the undersigned attorney in the form of a telephone call from Examiner Onuaku on July 24, 2008. On July 25, 2008, a copy of the referenced Office Action was made by the undersigned attorney from the official Patent Office record (Public PAIR). A copy of this Office Action, a report of all of the circumstances in this matter and a request that the client provide instructions for responding to this Office Action were sent by FAX to the instant attorney's client on July 25, 2008.

5. On July 25, 2008 a Petition to reinstitute the pendency of the above referenced application was drafted and filed in the Patent Office by FAX. That Petition set forth the facts in this matter in much the same manner as they have been set forth above. The facts set forth in this initial Petition support three (3) possible alternative remedies to this situation:

A. Withdraw the holding of abandonment based on applicant's failure to receive the referenced Office Action as provided for in 37 CFR 711.03(c)(I)(A);

B. Revive this application as having been unavoidably abandoned as provided for in 37 CFR 137(a); or

C. Revive this application as having been unintentionally abandoned as provided for in 37 CFR 1.137(b).

6. On September 8, 2008 the Patent Office issued a decision on the issues raised in the referenced Petition to wit: the Petition to Revive was dismissed subject to the instant applicant filing a further Petition to Revive on either an unavoidable or an unintentional abandonment basis, along with the appropriate fee, within two (2) months from the date of this decision. A further alternative was provided to the instant applicant in the footnote on page 1 of the decision to wit: file a Petition to Withdraw the Holding of Abandonment that carries no fee. The facts set forth above and in the initially filed Petition fully support any and all of these remedies.

DISCUSSION

It is clear that the facts in this matter, both as set forth above and as set forth in the original Petition to Revive, support a final ruling that applicant and the undersigned attorney bear no responsibility for this application having become abandoned for failure to timely respond to the Office Action of November 1, 2007. The Patent Office did not follow its own files that clearly set forth the correct present address of the undersigned attorney. Having failed to follow its own records by sending the referenced Office Action to the wrong address, the Patent Office and not the applicant or his attorney was the cause of applicant failing to respond to the outstanding Office Action in a timely manner. Had the Action been sent to the attorney's address of record, it would have been timely responded to and there would have been no need for the filing of this Petition.

Section 711.03(c)(I)(A) of the MPEP tells us that such a Petition does not require a fee. However, it does require a statement from a practitioner stating that the Office communication was not received. The undersigned attorney has made this statement in the original Petition that was filed in this matter. The undersigned attorney reiterates this statement in the instant renewed Petition. **Neither applicant nor the undersigned attorney received the Office Action of November 1, 2007 prior to July 24, 2008.**

The MPEP section requires that a search of the file jacket and of the docket record of the undersigned attorney be carried out to insure that, indeed the Office Action was not received.

While such a search might be warranted in some circumstances, in the instant matter it is clear from the Patent Office record itself that neither applicant nor the undersigned attorney could have received the Office Action as it was sent to an address where neither the applicant nor the attorney resided or carried out any business at the time that the Office Action was issued or at any other time since November 1, 2007. Copies of the undersigned attorney's docket records prior to July 24, 2008 would only produce blank sheets of paper for this application. There was nothing to record as the referenced Office Action was sent to the wrong address and not received. The undersigned attorney can and does attest to the fact that the referenced Office Action was not received prior to July 25, 2008 and that no docket record exists showing that the instant Office Action was received prior to July 25, 2008 when a copy of the Office Action was retrieved from PAI by the undersigned attorney.

It is also recognized that to support either a Withdrawal of a Holding of Abandonment or a Petition to Revive it is necessary that a complete response to the Office Action of November 1, 2007 must be submitted. Such a response is attached hereto and made a part of the instant Petition.

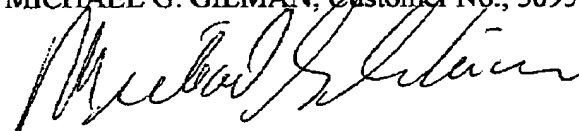
As noted above, a Petition to Withdraw a Holding of Abandonment requires no fee. Therefore, no fee is being filed herewith. However, it is recognized that if the instant Petition is considered to be in effect a Petition to Revive an unavoidably abandoned application, or an unintentionally abandoned application, there are fees that become due. While it is not believed that any fee is due in the instant matter, in the event that the Patent Office disagrees with this position and holds that a fee is due, it is requested that such fee be debited from the undersigned attorney's deposit account 50-3406.

It is urged that this matter be considered with significant urgency. The Patent office has recognized that this application has been pending for over 57 months (see page 3 of the recent Decision on Petition). Therefore, this application should be given priority prosecution status.

As noted above, a response to the outstanding Office Action is attached hereto as are copies of the two Change of Address forms that are of interest in this matter. Should the

examiner or the attorney acting on Petitions wish to discuss this matter further, the undersigned attorney is prepared to discuss this matter at their convenience. The attorney's signature below attests to the fact that this Petition has been filed in the Patent Office on the date set forth.

Respectfully submitted,
INTELLECTUAL PROPERTY LAW OFFICE of
MICHAEL G. GILMAN, Customer No.; 50955



Michael G. Gilman, Registration No. 19,114
Attorney for the applicant

Attachments:

424 Lantana Park
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Phone 859 272 0149
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Docket No. 041-2057C

September 18, 2008

SEP 18 2008



UNITED STATES PATENT AND TRADEMARK OFFICE

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424 LANTANA PARK
LEXINGTON KY 40515

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OFFICE OF PETITIONS

In re Application of :
Tsukidate :
Application No. 10/684,643 : **DECISION**
Filed 15 October, 2003 :
Attorney Docket No. 041-2057C :

This is a decision on the petition, filed on 25 July, under 37 C.F.R. §1.137(a)¹ for revival of an application abandoned due to unavoidable delay.

The petition under 37 C.F.R. §1.137(a) is **DISMISSED**.

Any further petition to revive must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(a)."

Petitioner's alternative is to file a petition under 37 C.F.R. §1.137(b), discussed below.

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

¹ A review of the extensive discussion at/in the guidance set forth in the commentary at MPEP §711.03(c)(1)(A) and (B) might suggest that the factual averments set forth in the instant petition may be appropriate for a petition (no fee) to withdraw the holding of abandonment and consideration under 37 C.F.R. §1.181. However, Petitioner's failure to seek relief timely under the rule (within two (2) months of the action complained of (Notice of Abandonment) leaves Petitioner with a petition to revive under the provisions of 37 C.F.R. §1.137(a) or (b) as the proper route to obtain a return to pending status for the instant application.

Application No. 10/684,643

As to Allegations of
Unavoidable Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(a) are the petition and fee therefor, a reply, a proper showing of unavoidable delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

It is noted from the outset that Petitioner's papers are problematic, *inter alia*, in that the relief alternatives that Petitioner seeks appear to be several and the showing(s) that Petitioner submits are not fully and separately set forth as required under the Rules of Practice. (37 C.F.R. §1.4(b).)

Petitioner entitles the instant petition as one "[t]o [r]evoke," however, Petitioner seeks relief under two separate provisions of the regulation—i.e., 37 C.F.R. §1.137(a) and §1.137(b), with the specifics of the request as to the latter left to little more than authorization of fees. Moreover, Petitioner seems to seek other relief for which a fee might not be required. Yet Petitioner is unspecific as to those details and fails to approach the matter as set forth by the guidance in the Commentary in the Manual of Patent Examining Procedure at MPEP §711.03(c) as to any of these alternatives. Such an approach is inconsistent with the duties outlined in *ex parte Pratt*.²

It is not proper for Office to attempt to guess at or otherwise interpret Petitioner's wishes as to relief sought herein, and the Office will not do so. Rather, the Office will limit this review to the provisions of 37 C.F.R. §1.137(a)—and the Office acts on the authorization to charge Deposit Account 50-3406 for that necessary fee.

The Office will not follow out at this writing Petitioner's generalized authorizations to charge additional fees for alternative form(s) of relief that may not be necessary.

Petitioner again is reminded that each transaction should be set forth in a separate paper as provided under the Rules of Practice. (37 C.F.R. §1.4(b) and (c).)

Rather, the Office notes that the requirements for a petition under the provisions of 37 C.F.R. §1.137(a) are set forth above (and in the regulation as well as in the discussion at available at MPEP §711.03(c)), both of which are available online at the Office website (www.uspto.gov), and those requirements include not only the petition, fee and showing of unavoidable delay, but also the required reply to the Office action to which Petitioner failed to respond. This requirement remains outstanding as of this writing. Petitioner further is reminded that the

² *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); *In re Mattullah*, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); *Ex parte Hendrich*, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

Application No. 10/684,643

appropriate forms for petitions under 37 C.F.R. §1.137(a) and (b) are available online as well at the Office website (www.uspto.gov). (Copies are enclosed herewith.)

Petitioner argues that the Office failed to track his series of Notices of Change of Address, and the Office notes that the substance of Petitioner's 13 November, 2005, Notice as to mailing address now has been entered.

Petitioner also is reminded that a practitioner/applicant who obtains a Customer Number and associates his/her/their application(s) with that Customer Number—as set forth in the MPEP and the Office website—may then be able to review at any time and online the status and condition of the their application(s), and so ease the diligence burden upon a practitioner/applicant as to attention to his/her/their applications under prosecution before the Office.

BACKGROUND

The record reflects as follows:

Petitioner failed to reply timely and properly to the non-final Office action (copy enclosed herewith) mailed on 1 November, 2007, with reply due absent extension of time on or before 1 February, 2008.

The instant application went abandoned by operation of law after midnight 1 February, 2008.

The Office mailed the Notice of Abandonment (copy enclosed) on 3 July, 2008.

Petitioner filed the instant petition on 25 July, 2008, averring inter alia, nonreceipt, but failing to provide documentary support (e.g., a copy of the docket record/file jacket cover for the instant application and discussion of Petitioner's docketing and calendaring system and a copy of the reply due-date calendar in support of the averments, as discussed at MPEP §711.03(c)).

Petitioner argues that the Office failed to track his series of Notices of Change of Address—the substance of Petitioner's 13 November, 2005, Notice as to mailing address now has been entered.

The Office notes that the requirements for a petition under the provisions of 37 C.F.R. §1.137(a) are set forth above, in the regulation and at MPEP §711.03(c). Those requirements include not only the petition, fee and showing of unavoidable delay, but also the required reply to the Office action to which Petitioner failed to respond, and this requirement remains outstanding as of this writing.

(It is noted that roughly during some fifty-seven (57) months between the date of deposit of the instant application the filing of the instant petition, Petitioner filed one Status Inquiry as to the instant application.)

Application No. 10/684,643

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.³

The availability of applications and application papers online to Petitioners/practitioners who diligently associate their Customer Number with the respective application(s) now provides practitioners on-demand information as to events/transactions in an application.

As to Allegations of Unavoidable Delay

The requirements under 37 C.F.R. §1.137(a) have not been satisfied as of this writing in that Petitioner failed to submit (the documentary showing and) the reply required.

CONCLUSION

Accordingly, The petition under 37 C.F.R. §1.137(a) is dismissed.

ALTERNATIVE VENUE

Petitioner may file a petition under 37 C.F.R. §1.137(b) and aver unintentional delay. (See: http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c)

A petition to revive on the grounds of unintentional delay must be filed promptly and such petition must be accompanied by the reply, the petition fee, a statement that “the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional” (the statement is in the form available online), and a terminal disclaimer and fee where appropriate.

Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

³ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See *Changes to Patent Practice and Procedure*, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(Petitioner obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).